



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,851	11/19/2001	Howard Sinkinson Marsden	08830-0124 DI1	9381

23973 7590 10/26/2004

DRINKER BIDDLE & REATH
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

EXAMINER

SALIMI, ALI REZA

ART UNIT	PAPER NUMBER
----------	--------------

1648

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,851

Applicant(s)

MARSDEN ET AL.

Examiner

A R Salimi

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) 20-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/230,405.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/19/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I (claims 15-19, and new claim 28) in the reply filed on 9/23/2004 is acknowledged.

Claims 20-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected groups.

Applicants are reminded to cancel the claims to the non-elected groups.

Priority

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number. Please, up-date the information by including the patent number.

Specification

The disclosure is objected to because of the following informalities: the sequences recited in the specification should be identified by a specific number. For example see pages 34, and 35, etc...

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Tenney et al (The Journal of Biological Chemistry, 1994, Vol. 269, No. 6, pp. 5030-5036).

The claims are directed to a product, an in vitro assay, to determine the ability of a substance to inhibit the association of UL8 and POL. Tanney et al in order to determine the role of UL8 and UL52; a polymerase protein of herpes virus; taught an in vitro assay that determined the association UL8 and UL52 as a helicase-primase complex. They also taught that addition of a substance such as substrate ATP and DNA would hinder the formation of UL8 and UL52 complex (see the abstract, page 5031, right column, 1st full paragraph, and pages 5034, top of the left column). Hence, the in vitro assay taught by the above cited article meets the broad limitations of the claimed product. Applicants are reminded that the limitations of the “providing the first viral component” and similar steps has no bearing on patentability when a product is claimed. The facts are Tanney et al taught the same product as now being claimed. They taught an assay where UL8 and POL were used and where substance i.e. ATP was used to determine the association of UL8 and POL. Therefore, the above cited art anticipates the claimed invention.

Art Unit: 1648

Claims 15-16, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Boehmer et al (PNAS, 1993, Vol. 90, pp. 8444-8448).

The claims are directed to a product, an in vitro assay, to determine the ability of a substance to inhibit the association of UL8 and POL. Boehmer et al taught interaction of UL9 and ICP8 and utilized serum antibody to detect and determine the association between the two said proteins (see page 8447, left column, 1st full paragraph). Hence, the in vitro assay taught by the above cited article meets the broad limitations of the claimed product. Applicants are reminded that the limitations of the "providing the first viral component" and similar steps has no bearing on patentability when a product is claimed. The facts are Boehmer et al taught the same product as now being claimed. The limitation of UL9, and ICP8 meet the "homologues" limitations of the claims. They taught an assay where UL8 and POL were used and where substance i.e. ATP was used to determine the association of UL8 and POL. Therefore, the above cited art anticipates the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1648

Claims 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tenney et al (The Journal of Biological Chemistry, 1994, Vol. 269, No. 6, pp. 5030-5036), and Smith et al (Journal of Virology, 1995, pp. 1734-1740).

As stated above Tanney et al determined the role of UL8 and UL52; and taught an in vitro assay that determined the association UL8 and UL52 as a helicase-primase complex. They also taught that addition of a substance such as substrate ATP and DNA would hinder the formation of UL8 and UL52 complex (see the abstract, page 5031, right column, 1st full paragraph, and pages 5034, top of the left column). This only differs since Tanney et al did not disclose UL102, and UL54.

Smith et al taught UL102, and UL54 and association of the two (see Table 1). They also identified many other similar proteins (see page 1734, left column, 2nd paragraph).

Therefore, one of ordinary skill in the art at the time of invention and in view of above teaching would have been motivated to form an in vitro assay for determining the ability of a substance to inhibit association of various polymerase complexes. Substituting a set of well known herpes proteins as taught by Tanney et al with another set of proteins as taught by Smith et al and utilized them in an in vitro assay identical to what Tanney et al disclosed would have been obvious. In addition, in view of the above cited art one of ordinary skill in the art would not have anticipated any unexpected results. Hence, the invention as a whole is prima facie obvious absent unexpected results.

Art Unit: 1648

Subject Matter Allowable over Prior art

Claim 28 is deemed free of prior art, given failure of the prior art to teach or reasonably suggest the SEQ ID NOs and their intended use as a short amino acid segment to be used in an in vitro assay.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. R. Salimi whose telephone number is (571) 272-0909. The examiner can normally be reached on Monday-Friday from 9:00 Am to 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (571) 272-0902. The Official fax number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

A. R. Salimi

10/21/2004


ALI R. SALIMI
PRIMARY EXAMINER